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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,732	10/11/2001	Ron L. Blackburn	268/227	6545
20985	7590	03/02/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	15
DATE MAILED: 03/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/682,732

Applicant(s)

BLACKBURN ET AL.

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10,12,13,21,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,12,13,21,23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10, 12, 13, 21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yant (6178644) in view of Brandon (4942679).

Yant shows an insert comprising a steel sheet (11), a cushion layer (21), orthopedic supports (32), and a top membrane (22) substantially as claimed except for the support being provided as part of the cushion layer. Brandon teaches forming a cushion layer (48) with orthopedic supports comprising a peripheral lip (53 and 54) and a metatarsal support (56) and the cushion layer is located between a rigid layer (35 and 36) and a top membrane layer (60). It would have been obvious to provide a shaped cushion layer as taught by Brandon for the cushion layer in the insert of Yant to increase support, comfort, and stability of the foot.

In reference to the exact thickness of the steel layer, Yant as modified above discloses the claimed invention except for the exact thickness of the steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use steel with a thickness of 0.02-0.025 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In reference to claims 10 and 24, Yant as modified above discloses the claimed invention except for the exact material for the cushion layer, Brandon suggests the use of open cell foams. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use open cell polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

3. Claims 10, 12, 13, 21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gates (UK 2264221) in view of Brandon (4942679).

Gates shows an insert comprising a steel sheet (8) and a cushion layer (9) substantially as claimed except for supports being provided as part of the cushion layer and a top membrane layer. Brandon teaches forming a cushion layer (48) with orthopedic supports comprising a peripheral lip (53 and 54) and a metatarsal support (56) and the cushion layer is located between a rigid layer (35 and 36) and a top membrane layer (60). It would have been obvious to provide a shaped cushion layer as taught by Brandon for the cushion layer in the insert of Gates to increase support, comfort, and stability of the foot.

In reference to the exact thickness of the steel sheet, Gates as modified above discloses the claimed invention except for the exact thickness of the steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use steel with a thickness of 0.02-0.025 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the

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optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In reference to claims 10 and 24, Gates as modified above discloses the claimed invention except for the exact material for the cushion layer, Brandon suggests the use of open cell foams. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use open cell polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

4. Applicant's arguments filed 2/9/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the limitation of "removability", both of the base references (Yant and Gates) are removable. Modifying the shapes/properties/etc. of these insoles as suggested by the Examiner would not affect the removability of the insoles.

In response to applicants' arguments directed towards the number of sheets of steel, it is noted that the claims do not preclude the addition of more layers. Therefore the reference to Yant shows all of the claimed limitations, i.e. it does have a single sheet, it also has additional elements. The fact that a reference show additional elements does not negate the fact that the reference does show all of the claimed elements.

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In response to applicants' arguments that Gates is vague on specifics, this does not negate what is shown and described and taught by Gates. The fact that Gates is vague leads one to believe that a variety or broad range of specifics, such as materials, shapes, thicknesses, etc. would be workable/usable and the specifics would be chosen according to the intended use.

In response to applicants' arguments directed towards the thickness of the steel sheet of Gates, it is noted that on page 6 lines 13-19 Gates specifically states that the "integral toe cap and insole may not be formed of single layers....instead be separate components.....and joined by any suitable means".

In response to applicants' arguments directed towards Brandon, Brandon has not been applied to show removability. Brandon has been applied to show the teachings for contouring (and the specific contour) of a cushion layer which is placed above a rigid layer and also teaches the well known and conventional practice of providing a membrane layer over a cushion layer to make the layer more comfortable next to the wearer's foot. Brandon clearly provides the motivation for contouring a cushion layer which is located above a rigid layer as it is clearly stated not only throughout the reference, but in the title "styled comfort shoe". If one were looking at footwear insoles on suggestions for how to make an insole more comfortable, one would clearly and obviously look to references such as Brandon which are directed towards comfort insoles. There is no requirement when modifying references to import ALL of the elements of the modifying reference (actually if it were, then the modifying reference would be an anticipatory reference). By contouring the cushion layer of the base

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references as taught by Brandon does not affect the removability of the base references.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson  
Primary Examiner  
Art Unit 3728